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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,097	12/27/2000	Hideki Toshikage	7254/63305	6249
7590	04/19/2005		EXAMINER	
JAY H. MAIOLI Cooper & Dunham LLP 1185 Avenue of the Americas New York, NY 10036			CHEUNG, MARY DA ZHI WANG	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/749,097

**Applicant(s)**

TOSHIKAGE ET AL.

**Examiner**

Mary Cheung

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 and 36-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 and 36-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Status of the Claims***

1. This office action is in response to the amendment filed on January 3, 2005. Claims 1-34 and 36-39 are pending. Claims 1, 18 and 36 are amended. Claim 35 is canceled.

### ***Response to Arguments***

2. Applicant's arguments filed January 3, 2005 have been fully considered but they are not persuasive.

Applicant argues that Ginter (U. S. Patent 5,892,900) fails to the newly added limitation that accepting a selection of a receiver said form a plurality of receiver sides. Examiner respectfully disagrees because this limitation is taught by Ginter as pay-per-view (column 54 lines 37-56).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Ginter teaches the digital image being transmitted including pictures (column 59 lines 28-30 and column 283 lines 5-12), Ginter also teaches an image scanner for converting a document into digital image (column 299 lines 36-42). Ginter does not explicitly teach the image scanner is a photographic image scanner for converting a picture on a

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photographic film into a digital image. However, Ginter specifically states that "Almost any sort of transaction you can think of can be supported by virtual distribution environment" (column 53 lines 53-54), and Garfinkle (U. S. Patent 6,017,157) teaches an image scanner that converts a picture on a photographic film into a digital image (column 2 lines 53-61 and column 3 lines 34-51 and Figs. 1, 3). It would have been obvious to one of ordinary skill in the art at the time the inventions was made to allow the image scanner in Ginter's teaching to be a photographic image scanner for converting a picture on a photographic film into a digital image because it would allow the picture related data to be better captured, efficiently stored, and later to be better distributed.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-34 and 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al., U. S. Patent 5,892,900 in view of Garfinkle et al., U. S. Patent 6,017,187.

As to claim 1, Ginter teaches an image commercial transactions system comprising (Fig. 1):

a) A reception dealer having an image scanner for converting a document into a digital image and for accepting a sale of said digital image with a handling

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condition associated with said digital image and for accepting a selection of a receiver side from a plurality of receiver sides, for selling said digital image with said handling condition in a digital data format, and for transferring said digital image with said handling condition in said digital data format to said selected receiver side via an Internet line so that said digital image is developed at said selected receiver said into a printed picture modified based on said handling condition (column 53 lines 39-60 and column 54 lines 26-56 and column 299 lines 36-42 and Figs. 1, 15A; *specifically, "a handling condition" corresponding to the "rules and controls" in Ginter's teaching, and the digital image is delivered in a restricted format at the consumer side according to the handling condition*);

b) A charge accounting dealer for effecting an electronic charging accounting transaction for the purchase of said digital image with said handling condition in said digital data format, and accepting a request from a customer to purchase said digital image (column 55 lines 44-60 and column 58 lines 23-63 and Figs. 1A, 3-4).

Ginter teaches the digital image being transmitted including pictures (column 59 lines 28-30 and column 283 lines 5-12), Ginter also teaches an image scanner for converting a document into digital image as discussed above. Ginter does not explicitly teach the image scanner is a photographic image scanner for converting a picture on a photographic film into a digital image. Garfinkle teaches an image scanner that converts a picture on a photographic film into a digital image (column 2 lines 53-61 and column 3 lines 34-51 and Figs. 1, 3). It would have been obvious to one of ordinary skill

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in the art at the time the inventions was made to allow the image scanner in Ginter's teaching to be a photographic image scanner for converting a picture on a photographic film into a digital image because it would allow the picture related data to be better captured, efficiently stored, and later to be better distributed.

Ginter does not specifically teach the reception dealer shows a thumbnail image associated with said digital image to a customer. However, Garfinkle teaches displaying thumbnail images to a user (column 5 lines 10-29 and column 6 line 56 – column 7 line 15). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the reception dealer in Ginter's teaching to include the feature of displaying a thumbnail image to the customer so that the customer is able to quickly and easily view the image.

As to claim 2, Ginter teaches said reception dealer generate predetermined additional information for said digital image, and distributes said generated additional information in a digital format, along with said handling condition data containing information of a selling price of said digital image data (column 54 lines 26-56).

As to claim 3, Ginter teaches said reception dealer distributes said additional information data containing information as to a payment condition for purchasing said digital image data, information as to a recorder's name of said digital image data, information as to a recorder's history of said digital image data, information as to a type of data format of said digital image data, information as to advertisement data synthesized with said digital image data, text information data synthesized with said digital image data, and processing information data synthesized with said digital image

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data (column 24 lines 24-53 and column 54 lines 26-56 and column 317 lines 22-42 and column 320 lines 2-20).

As to claim 4, Ginter teaches said reception dealer distributes said digital image data subjected to a scrambling process (column 59 lines 48-54).

As to claim 5, Ginter teaches said reception dealer distributes said additional information data containing information as to whether said digital image data is subjected to said scrambling process (column 59 lines 48-67).

As to claim 6, Ginter teaches said reception dealer distributes said additional information data containing predetermined key data useful in said scrambling process for said digital image data (column 59 lines 48-67).

As to claim 7, Ginter teaches said reception dealer distributes said digital image data subjected to a masking process (column 150 lines 35-43).

As to claim 8, Ginter teaches said reception dealer distributes said additional information data containing information as to whether said digital image data is subjected to said masking process (column 150 lines 35-43).

As to claim 9, Ginter teaches a delivery dealer for receiving and delivering said digital image with said handling condition data to a purchaser (column 54 line 18 – column 55 line 31).

As to claim 10, Ginter teaches said delivery dealer synthesizes said advertisement data contained in said additional information data and said digital image for delivery to said purchaser (column 317 lines 22-42 and column 320 lines 2-20).

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As to claim 11, Ginter teaches said delivery dealer synthesizes said text information data contained in said additional information data and said digital image data for delivery to said purchaser (column 317 lines 22-42 and column 320 lines 2-20).

As to claim 12, Ginter teaches said delivery dealer synthesizes said processing information data contained in said additional information data and said digital image data for delivery to said purchaser (column 317 lines 22-42 and column 320 lines 2-20).

As to claim 13, Ginter teaches a delivery dealer for receiving and delivering said digital image data with said handling condition to a purchaser, wherein said delivery dealer performs a descrambling process of said digital image data based on said key data contained in said additional information data for delivery to said purchaser (column 54 line 18 – column 55 line 31 and column 59 lines 42-67).

As to claims 14-16 and 30-32, Ginter teaches said delivery dealer synthesizes said advertisement data, said text information data, or processing information data contained in said additional information data and said digital image data for delivery to said purchaser as discussed above (column 317 lines 22-42 and column 320 lines 2-20).

Ginter does not specifically teach the reception dealer changes said selling price of said digital image data depending on whether said advertisement data, said text information data, or said processing information is synthesized with said digital image data. However, Ginter teaches reception dealer gives a discounted price for a certain quantity of certain data, and supports advertising for the purpose of lower price to the users (column 22 lines 33-52 and column 30 lines 40-48). It would have been obvious



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to one of ordinary skill in the art to allow the reception dealer of Ginter to change the selling price of the digital image data based on whether certain information (i.e. advertisement) is synthesized with the digital image data because users could receive a discounted price of the purchase by reviewing the synthesized data, and the data provider could also be benefit by promoting its products through the synthesized data.

As to claims 17 and 33-34, Ginter teaches reception dealer gives a discounted price for a certain quantity of certain data, and supports advertising for the purpose of lower price to the users (column 22 lines 33-52 and column 30 lines 40-48). Ginter does not specifically teach the reception dealer changes said selling price of said digital image data depending on whether said digital image data is subjected to said scrambling process or said masking process. However, Ginter teaches charging fees based on the services that are provided to the user, such as fees for decrypting data (column 42 line 35 – column 43 line 20). It would have been obvious to one of ordinary skill in the art to allow the reception dealer of Ginter to change the selling price the digital image data based whether the scrambling process or the masking process are performed so that the digital image data provider can be better compensated for the services that provided to the users.

As to claim 18, Ginter teaches an image commercial transactions method comprising (Fig. 1):

- a) An image scanning step for converting a document into a digital image (column 299 lines 36-42);

- b) A reception step of enabling a reception dealer to accept a request for a sale of said digital image with a handling condition associated with to said digital image and to accept a selection of a receiver said from a plurality of receiver sides (column 53 lines 9-60 and column 54 line 26 – column 55 line 31 and column 299 lines 36-42 and Figs. 1, 15A; *specifically, "a handling condition" corresponding to the "rules and controls" in Ginter's teaching*);
- c) A sale step of enabling said reception dealer to sell said digital image with said handling condition in a digital data format (column 53 lines 9-60 and column 54 line 26 – column 55 line 31 and Figs. 1, 15A);
- d) A transferring step for transferring said digital image with said handling condition in said digital data format to said selected receiver side via an Internet line so that said digital image is developed at said selected receiver said into a printed picture modified based on said handling condition (column 53 lines 39-60 and column 54 lines 26-56 and column 299 lines 36-42 and Figs. 1, 15A; *specifically, this limitation corresponding to the digital image is delivered in a restricted format at the consumer side according to the handling condition in Ginter's teaching*);
- e) A charge accounting step of enabling a charge accounting dealer to effect an electronic charge accounting transaction for a purchase of said digital image with said handling condition in said digital data format (column 55 lines 44-60 and column 58 lines 3-63 and Figs. 1A, 3-4).

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Ginter teaches the digital image being transmitted including pictures (column 59 lines 28-30 and column 283 lines 5-12), Ginter also teaches an image scanning step for converting a document into digital image as discussed above. Ginter does not explicitly teach the image scanning step is for converting a picture on a photographic film into a digital image. Garfinkle teaches an image scanning step for converting a picture on a photographic film into a digital image (column 2 lines 53-61 and column 3 lines 34-51 and Figs. 1, 3). It would have been obvious to one of ordinary skill in the art at the time the inventions was made to allow the image scanning step in Ginter's teaching include the feature of converting a picture on a photographic film into a digital image because it would allow the picture related data to be better captured, efficiently stored, and later to be better distributed.

As to claims 18 and 36-39, Ginter further teaches a publication step that displays transaction history (column 24 lines 24-53 and column 258 line 30 – column 259 line 12 and Fig. 72D). Ginter discloses the claimed invention, as discussed above, except for the step of displaying collectively digital image to be sold, or displaying the digital image to be sold together with a payment condition for purchasing the digital image or with a recorder's name of digital image or with a recorder's history. It would have been an obvious matter of design choice to modify the teachings of Ginter to provide the step of displaying such contents. Since the applicant has not disclosed that displaying collectively digital image to be sold, or displaying the digital image to be sold together with a payment condition for purchasing the digital image or with a recorder's name of digital image or with a recorder's history solves any stated problem in a new or

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unexpected way or is for any particular purpose which is unobvious to one of ordinary skill and it appears that the claimed feature does not distinguish the invention over similar features in the prior art since, the teachings of Ginter will perform the invention as claimed by the applicant with any means, method, or product to display such contents.

Claims 19-29 are rejected for the similar reasons as claims 2-13.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Inquire***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is 571-272-6705. The examiner can normally be reached on M-Th (10:00-7:30) Second Friday Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mary Cheung  
Patent Examiner  
Art Unit 3621  
April 8, 2005

